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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/302,471	04/30/99	SHIBUYA T	774-98129

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EXAMINER	
BRUNSMAN, D	
ART UNIT	**PAPER NUMBER**
1755	4

DATE MAILED: 09/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/302,471	Applicant(s) Shibuya et al
	Examiner David M. Brunsman	Group Art Unit 1755

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-16* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-16* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *3*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Adachi et al (CA PLUS AN 1988:514996).

The reference teaches a composition formed by mixing one mole tetramethoxy silane, one mole dimethylformamide, methanol, 10 moles water and 0.001 moles ammonia heated wherein the methanol would be driven off first to be replaced completely by the DMF. The temperature is raised while drying at 150^{0}C. The dried material is sintered by increasing the temperature through 1050^{0}C (the material passing through the entire range of 350-800^{0}C).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adachi et al as applied above, and further in view of Takei et al (CA PLUS AN 1997:542658).

The difference between Adachi et al and the instant claims is that Adachi et al is directed to formation of glass monoliths. Takei et al teach that similar sol-gel type systems can be used to

form monoliths or coating films. It would have been obvious to one of ordinary skill in the art to use the compositions and curing conditions of Adachi et al to form films because Takei et al teach such compositions can be used to form films. Furthermore, the difference between monolith and coating is one of shape and a change of shape would have been obvious to one of ordinary skill in the art for the reasons set forth in *In re Dailey et al.*, 149 USPQ 47 and, *Goodrich v. Gates,* 12 USPQ 147. The similar compositions and curing conditions employed would be expected to produce products with similar properties such as the dielectric constant of claim 16.

Claims 1-3, 5, 6 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomikawa et al (CA PLUS AN 1995:248289).

The reference teaches a coating composition comprising methyltrimethoxysilane, water, N-methyl pyrrolidone and a base and, the film formed therefrom. The similar compositions employed would be expected to produce products with similar properties such as the dielectric constant of claim 16.

In determining the relevant art one looks to the nature of the problem confronting the inventor. *Weather Engineering Corp. of America v. United States*, 204 USPQ 41, 46-47.

Having thus determined the scope and content of the prior art and the level of skill in the said art at the time the invention was made, it is the examiner's position that the claimed invention, as a whole, would have been obvious to one of ordinary skill in the art at the time the invention was made.

The mere failure of a reference to disclose all the advantages asserted by applicant is no a substitute for actual differences in properties. *In re DeBlauwe*, 222 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean form the cited prior art. *Titanium Metals Corp. v. Banner*, 227 USPQ 773.

Accordingly, the burden of proof is upon applicant to show that the instantly claimed subject matter is different form and unobvious over that taught by the prior art relied upon. *In re Brown*, 173 USPQ 685, 689; *In re Best*, 195 USPQ 430; *In re Marosi*, 21 USPQ 289, 293.

Any evidence to be presented under 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next office action will be a final rejection.

Any foreign language documents submitted by applicant have been considered to the extent the short explanation of significance, English abstract or English equivalent allow.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is (703) 308-3454. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays from 6:30 am to 5:00 pm eastern time. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

DMBrunsman
September 16, 2000

David M. Brunsman
Primary Examiner
Group 1755